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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,477	12/10/2003	Shoji Yamada	P24167	5420

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

NGUYEN, KIMNHUNG T

ART UNIT	PAPER NUMBER
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2629

NOTIFICATION DATE	DELIVERY MODE
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10/16/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No. 10/731,477	Applicant(s) YAMADA, SHOJI	
	Examiner Kimnhung Nguyen	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,8-11 and 13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 6,8-11 and 13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Newly submitted claims 14 and 15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The limitation a pad contact portion having a first end hingedly connected to an end of said grip portion, and a second end comprising an electrically-conductive generally planar pad contact face configured to contact the touchpad” are directed to different embodiment, would require additional search and/or consideration.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14 and 15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. This application has been examined. The claims 6, 8, 9-11 and 13 are pending. The examination results are as following.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 8, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mart (US 6,794,609) in view of Natsuyama et al. (US 2001/0028345).

As to claim 6, Mart discloses in fig. 1, an input element (prosthetic 100), used for a touch-pad (touch screen display 100) disposed to an information processing apparatus, said touch-pad being responsible to changes of a static capacitance (see col. 1, lines 30-31), said input element (100) comprising: an electrically-conductive generally planar pad contact face (electrically conductive touchpad 108, has a planar shaped) configured to contact the touch-pad (20, see col. 3, lines 37-48, col. 4, lines 66-67 and col. 5, lines 1-2). However, Mart does not disclose an electrically-conductive outer grip configured to electrically contact a hand of a user, said grip and said pad contact face being pivotally connected to each other.

Natsuyama et al. discloses in fig. 1, an input pen for a touch panel comprising an outer grip (see holder 4 or 14) contact a hand of a user, the grip being pivotally connected to each other (corresponds to a holder which is movable along the axial direction of the input pen and has an opening at the tip end thereof, see col. 0016), the holder should make of metal because Natsuyama et al. discloses that **even if the touch ball 3 is made of metal or the like, the same effects as described above can be produced by using the above described configuration including the spring 5 or the holder 4 or 14, see 0069**). Clearly, Natsuyama et al. discloses the outer grip is an electrically-conductive.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electrically-conductive outer grip by holder (4 or 14) contact a hand of a user, the grip being pivotally connected to the holder as taught by Natsuyama et al. into the input element for use with a touchpad of an information of Mart for producing the

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claimed invention because this would be possible to configure the input pen excellent in the using feeling without any interference with the visual confirmation of a portion indicated on the screen 100 of the touch panel by the input pen (see 0047).

As to claim 8, Mart discloses further, the input element having a pencil-shape body (see col. 1, lines 25-28); and the input element is configured to input data to the information processing apparatus via the changes of static capacitance.

As to claim 9 is rejected the same reasons as claim 8.

As to claim 11 is rejected the same as reasons of the claim 6.

5. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mart (US 6,794,609) and Natsuyama et al. (US 2001/0028345) as applied to claims 6 and 11 above, and further in view of Toyoda et al. (US 5,210,405).

As to claims 10 and 13, Mart and Natsuyama et al. do not disclose the contact face is generally circular; however, Toyoda et al. disclose in fig. 1, an input pen includes a touch ball is rotatably supported by an end of a pen-like elongate handle that is a contact face in circular (see abstract, see col. 4, lines 21-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the pen-type input device comprising a ball rotatable supported by an end of a pen-like elongate handle as taught by Toyoda et al. into the system of Mart and Natsuyama et al. for producing the claimed invention because this would provide the direction of rotation and the amount of movement of each respective rotating member is detected by the

detecting circuit and detected data are sent to a computer whereby a curve corresponding to the movement of the ball is creased on a display surface of the computer (see abstract).

Response To Arguments

6. Applicant's arguments with respect to claims 6-13 filed on 7/25/07 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimnhung Nguyen whose telephone number is (571) 272-7698. The examiner can normally be reached on MON-FRI, FROM 8:30 AM-5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kimnhung Nguyen
Patent Examiner
October 5, 2007



RICHARD HJERPE
SUPERVISOR OF PATENT EXAMINERS
OCTOBER 5, 2007